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In re Application of
Leonard Arnold Duffy
Application No. 10/015,087
Filed: October 19, 2001
Attorney Docket No. None

Paper No. 11
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DEC 3 0 2003

OFFICE OF PETITIONS

DECISION ON PETITION

This is a decision on the petition filed June 19, 2003, under 37 CFR 1.78(a)(6) requesting acceptance of an unintentionally delayed claim for benefit of the prior-filed provisional applications under 35 U.S.C. 119(e) and the petition under 37 CFR 1.183 requesting waiver of 37 CFR 1.78(a)(6) "as that rule operates in conjunction with 37 C.F.R. § 1.17(t)."

The petition considered under 37 CFR 1.78(a)(3) is **dismissed**.

The petition considered under 37 CFR 1.183 is **dismissed**.

Any request for reconsideration of this decision must be filed within two months from the mailing date of this decision. Note 37 CFR 1.181(f).

WITH RESPECT TO THE PETITION UNDER 37 CFR 1.78(a)(6):

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(5)(ii). In addition, the petition under 37 CFR 1.78(a)(6) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The petition lacks item (2) above.

Accordingly any renewed petition must clearly be captioned for relief under 37 CFR 1.78(a)(6) and either include the fee or clearly authorize its charge to a deposit account.

WITH RESPECT TO WAIVER OF THE SURCHARGE REQUIRED BY 37 CFR 1.78(A)(3)(ii) AND 37 CFR 1.17(t).

Petitioner requests under 37 CFR 1.183 waiver of the applicable surcharge under 37 CFR 1.78(a)(6)(ii) for the acceptance of an unintentionally delayed claim for priority under 35 U.S.C. § 119(e) as set forth in 37 C.F.R. § 1.17(t). In this regard, petitioner states that priority status was requested by including the following paragraph on the first page of the application, after the title and immediately before the beginning paragraph of the specification entitled "Field of Invention":

"Ref Provisional patent applications
60/228,780 05/05/2001
60/241,707 10/19/2000"

However, a typographical error occurred in that provisional Application No. 60/228,780 should have read 60/288,780. Additionally, there was no clear priority claim to the provisional applications.

37 CFR 1.183 states that:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(h).

OPINION

In order to grant any petition under 37 CFR 1.183, petitioner must show (1) that this is an extraordinary situation where (2) justice requires waiver of the rule. In re Sivertz, 227 U.S.P.Q. 255, 256 (Comm'r Pat. 1985). Petitioner has not shown that either condition exists in this case.

The circumstances of this case do not demonstrate an extraordinary situation, much less one where justice requires waiver of the rules. The failure to timely submit a proper claim for priority of the earlier applications within the time period set forth in 37 CFR 1.78(a)(ii) was a circumstance entirely within petitioner's control, and could have been avoided by the exercise of reasonable care and diligence. Equitable powers should not be invoked to excuse the performance of a condition by a party that has not acted with reasonable, due care and diligence. U.S. v. Lockheed Petroleum Services, 709 F.2d 1472, 1475 (Fed. Cir. 1983). Furthermore, since the USPTO did not cause or contribute to petitioner's filing delay, this case is even further removed from consideration as one where "justice requires" equitable relief. See Helfgott & Karras, P.C. v. Dickinson, 209 F.3d 1328, 54 USPQ2d 1425 (Fed. Cir. 2000).

It is well settled that a party's inadvertent failure to comply with the requirements of the rules or procedures before the USPTO is not deemed to be an extraordinary situation that would warrant waiver of the rules or procedures under 37 CFR 1.183. See Honigsbaum v. Lehman, 903 F. Supp. 8, 37 USPQ2d 1799 (D.D.C. 1995) (Commissioner did not abuse his discretion in refusing to waive requirements of 37 CFR 1.10(c) in order to grant filing date to patent application, where applicant failed to produce "Express Mail" customer receipt or any other evidence that application was actually deposited with USPS as "Express Mail"), *aff'd without opinion*, 95 F.3d 1166 (Fed. Cir. 1996); Nitto Chemical Industry, Co., Ltd. v. Comer, 39 USPQ2d 1778, 1782 (D.D.C. 1994) (Commissioner's refusal to waive requirements of 37 CFR 1.10 in order to grant priority filing date to patent application not arbitrary and capricious, because failure to comply with the requirements of 37 CFR 1.10 is an "avoidable" oversight that could have been prevented by the exercise of ordinary care or diligence, and thus not an extraordinary situation under 37 CFR 1.183); Gustafson v. Strange, 227 USPQ 174 (Comm'r Pats. 1985) (Counsel's unawareness of 37 CFR 1.8 not extraordinary situation warranting waiver of a rule). Rather, as petitioner failed to comply with the provisions of 37 CFR 1.78(a)(5)(i), (ii) and (iii), this is not an "extraordinary situation" where "justice requires" an extraordinary remedy.

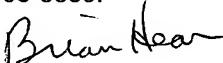
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